



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,867	11/12/2003	James McLennan	1528	6733
4518	7590	04/14/2009		
ROBERT W. J. USHER PATENT AGENT 1133 BROADWAY, #1515 NEW YORK, NY 10010			EXAMINER BAROT, BHARAT	
			ART UNIT 2455	PAPER NUMBER
			MAIL DATE 04/14/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/706,867	Applicant(s) MCLENNAN ET AL.	
	Examiner Bharat N. Barot	Art Unit 2455	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15, 17-28 and 33-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15, 17-28, and 33-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

RESPONSE TO AMENDMENT

1. Claims 1-15, 17-28, and 33-35 remain for further examination.

The new grounds of rejection

2. Applicants' amendments and arguments with respect to claims 1-15, 17-28, and 33-35 filed on December 29, 2008 have been fully considered but they are deemed to be moot in view of the new grounds of rejection.

Claim Rejections - 35 USC § 103(a)

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-15, 17-28 and 33-35 are rejected under 35 U.S.C.103 (a) as being unpatentable over Pollack (U.S. Patent No. 6,505,236) in view of Fahlman et al (U.S. Patent No. 5,960,080).

Art Unit: 2455

5. As to claim 1, Pollack teaches a method for directing an automatic communication to a recipient (see abstract, and figures 1-2), including the steps of: providing a data store; storing data relating to the recipient in the data store; examining the data stored and determining that a communication is to be provided to the recipient; extracting data relating to the recipient from the data store in response to a determination that a communication is to be provided to the recipient; and sending a final communication to the recipient (figures 1-2, and column 4 line 4 to column 7 line 17).

However, Pollack does not teach the steps of: automatically composing an initial communication in response to the data stored in the data store; reviewing the initial communication and, passing the initial communication to be modified to become a final communication when stored data extracted when composing the initial communication indicates that human modification is required and, treating the initial communication as the final communication without passing to be modified, when stored data extracted when composing the initial communication indicates that human modification is not required.

Fahlman et al teach the steps of: automatically composing an initial communication in response to the data stored in the data store; reviewing the initial communication and, passing the initial communication to be modified to become a final communication when stored data extracted when composing the initial communication indicates that human modification is required and, treating the initial communication as the final communication without passing to be modified, when stored data extracted

Art Unit: 2455

when composing the initial communication indicates that human modification is not required; and sending a final communication to the recipient (see abstract; figures 1-2; and column 3 line 28 to column 5 line 40).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Fahlman et al stated above in the method of Pollack for directing an automatic communication to a recipient because it would have promoted efficient planning and work flow in the network, maximized the utilization of the network by limiting the sizes and formats of the messages, and increased the security of the data communications (messages).

6. As to claim 2, Pollack teaches that the step of: modifying the initial communication comprises modifying the initial communication in a manner selected in response to the data extracted from the data store (figures 1-2, column 4 lines 3-39, and column 7 lines 1-6).

7. As to claim 3, Pollack teaches that the step of: modifying the initial communication comprises at least one of: deleting material from the initial communication; adding new material to the initial communication; providing material of predetermined fixed content and adding the material of predetermined fixed content to the initial communication; providing material of predetermined alterable content and adding the material of predetermined alterable content to the initial communication; and altering material already provided in the initial communication (figures 1-2; column 5 lines 17-67; and column 7 lines 6-10) (see also Fahlman et al figures 1-2 and column 3 line 28 to column 5 line 40).

Art Unit: 2455

8. As to claims 4-5, Fahlman et al teach that the steps of: providing access to a plurality of selectable media for providing the final communication to the individual; selecting, in response to the data extracted from the data store, at least one medium of the plurality of selectable media for providing the final communication to the individual; and employing said at least one medium to send the final communication, wherein the plurality of selectable media comprises facsimile transmission; telephonic text messaging; data transmission; Internet Communication; and mailing of printed letters (column 3 lines 27-34, column 4 lines 20-27, column 6 line 62 to column 7 line 6, and column 7 lines 41-46).

9. As to claims 6-7, Fahlman et al teach that the steps of: providing access to a plurality of selectable media for providing the final communication to the individual; selecting, in response to the data stored, at least one medium of the plurality of selectable media for providing the final communication to the individual; and employing said at least one medium to send the final communication, wherein the plurality of selectable media comprises facsimile transmission; telephonic text messaging; data transmission; Internet Communication; and mailing of printed letters (figure 6, column 6 line 17 to column 7 line 6, and column 7 lines 41-46).

10. As to claim 8, Pollack teaches that the step of: storing data relating to the recipient in a data store comprises the step of providing access to and accepting data relating to the recipient from at least one of: the Internet; a digital data transmission medium; telephonic text messages; telephonic voice messages; printed matter; data

Art Unit: 2455

files; and record data files (figure 1; and column 5 lines 17-36) (see also Fahlman et al figure 6 and column 6 line 17 to column 7 line 6)

11. As to claims 9-10, Fahlman et al teach that the steps of: automatically composing an initial communication in response to the data stored in the data store comprises the step of providing composition text in a plurality of languages, selecting one of the languages in response to the data stored relating to the recipient and composing the initial communication in the language selected, wherein the step of modifying the initial communication comprises modifying the initial communication in a same language as a language selected for the initial communication (column 1 lines 27-52, and column 7 lines 5-64).

12. As to claims 11-12, Fahlman et al teach that the step of: automatically composing an initial communication in response to the data stored in the data store includes the step of providing a plurality of idioms for the initial communication and selecting one of the plurality of idioms for the initial communication in response to data relating to the recipient extracted from the store, wherein the step of modifying the initial communication comprises modifying the initial communication in a same idiom as an idiom selected for the initial communication (figures 2-3, and column 4 line 16 to column 5 line 40).

13. As to claims 13-14, Fahlman et al teach that the steps of: automatically composing an initial communication in response to the data stored in the data store includes the step of providing a plurality of forms of composition suitable for use in

Art Unit: 2455

respective individual jurisdictions; and selecting a particular jurisdiction with the respective form of composition in response to the data relating to the recipient extracted from the store; and, composing the communication in the respective form of composition, wherein the step of modifying the initial communication comprises modifying the initial communication with material suitable for use in a same jurisdiction as the initial communication (figures 2-5, and column 4 line 16 to column 5 line 40).

14. As to claims 15-28, they are also rejected for the same reasons set forth to rejecting claims 1-14 above, since claims 15-28 are merely an apparatus for the method of operations defined in the claims 1-14.

15. As to claims 33-35, they are also rejected for the same reasons set forth to rejecting claims 1-14 above, since claims 29-33 do not teach or define any new limitations than above claims 1-14.

Response to Arguments

16. Applicant's arguments have been fully considered. The examiner has attempted to answer (response) to the remarks (arguments) in the body of the Office action.

Additional References

17. The examiner as of general interest cites the following references.

- a. Marriott et al, U.S. Patent No. 7,277,951.
- b. Boucher et al, U.S. Patent No. 5,884,246.

Art Unit: 2455

Contact Information

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Bharat Barot** whose Telephone Number is **(571) 272-3979**. The examiner can normally be reached on Monday-Friday from 7:00 AM to 3:30 PM. Most facsimile-transmitted patent application related correspondence is required to be sent to the Central FAX Number **(571) 273-8300**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Saleh Najjar**, can be reached at **(571) 272-4006**.

/Bharat N Barot/

Primary Examiner, Art Unit 2455

April 07, 2009